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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,096	08/31/2005	Robert A Levine	186253/US-475387-00112	8398

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DORSEY & WHITNEY LLP
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250 PARK AVENUE
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EXAMINER

JOHNSON III, HENRY M

ART UNIT	PAPER NUMBER
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3769

MAIL DATE	DELIVERY MODE
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12/31/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/523,096	Applicant(s) LEVINE ET AL.	
	Examiner HENRY M. JOHNSON III	Art Unit 3769	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is **non-final**.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 56-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,2 and 56-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 August 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Response to Arguments

Following receipt of the Appeal Brief, a subsequent search uncovered art that is interpreted as better anticipating the claims. Accordingly, all previous rejections are withdrawn as is the finality of the last office action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 60 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The distal portion is curved, thus presenting multiple angles. Further, an acute angle is not disclosed in the specification, thus the drawings are the only disclosure of the angle. The extreme distal end, as seen in the drawings, is at a 90 degree angle, not an acute angle.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 56, 57, 62-65 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,558,664 to Boyd et al. Boyd et al. teach a catheter for cardiac procedures with a grasping element (Fig. 5, # 71) for holding tissue to be cut (Col. 13, lines 60-61) and cutting blades (Fig. 5, #s 68 & 69) arranged in a pincer configuration. As the blades are on an independent element, they are rotatable relative to the catheter. Both the cutting elements and

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the grasping element extend from an opening of the catheter and are capable of grasping and severing a chord. The catheter includes an inflatable balloon (Fig. 5, # 11) for stabilizing the catheter within the heart.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent 5,558,664 to Boyd et al. Boyd et al. do not specifically disclosed the size of the cutting blades, however, a skilled artisan would select the blade configuration best suited for the intended task making the blade size an obvious design consideration. The use of shaped memory elements in catheters is pervasive in the art. One of skill in the art would select such elements to achieve a required shape of an element when deployed from a restricted area such as a catheter lumen.

Claims 58-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent 5,558,664 to Boyd et al. as applied to claim 57 above and further in view of U.S. Patent 6,629,534 to St. Goar et al. Boyd et al. are discussed above, but do not teach a wire grasping element. St. Goar et al. disclose a cardiac catheter with multiple capture coils (Fig. 32A, # 60 & 62) intended for grasping chordae, the coils may be loops of nitinol (Col. 25, lines 45-55). The loops being circular, they have portions that are at an acute angle to the opening of the catheter. It would have been obvious to one skilled in the art to use the loops as taught by St. Goar et al. in the invention of Boyd to capture tissue, such as chordae, during a cardiac procedure as both

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catheters are intended for such procedures and a skilled artisan would be motivated to seek prior work.

Claim 67 is rejected under 35 U.S.C. 103(a) as being unpatentable over Patent 5,558,664 to Boyd et al. as applied to claim 1 above and further in view of U.S. Patent 6,283,127 to Sterman et al. Boyd et al. are discussed above, but do not teach multiple catheters for a cardiac procedure. The use of multiple access devices for a cardiac procedure is well known as evidenced by Sterman et al. It would have been obvious to one skilled in the art to use multiple access devices as taught by Sterman et al. in the invention of Boyd et al. to allow for different tools with independent positioning.

Conclusion

Any inquiry concerning this communication should be directed to HENRY M. JOHNSON III at telephone number (571)272-4768.

/Henry M. Johnson, III/
Supervisory Patent Examiner, Art Unit
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